

Office Action Summary

Application No.
08/964,257

Applicant(s)

Terashima et al

Examiner
Madeleine AV Nguyen

Group Art Unit
2722



☒ Responsive to communication(s) filed on Jun 15, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 7-10, 19-25, and 34-61 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 7-10, 24, 25, 38-45, and 51 is/are allowed.

☒ Claim(s) 19-23, 34-36, 46, 48-50, 52-54, and 56-61 is/are rejected.

☒ Claim(s) 37, 47, and 55 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Madeleine Nguyen
MADELEINE NGUYEN
PATENT EXAMINER

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— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on June 15, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/964,257 is acceptable and a CPA has been established. An action on the CPA follows.

Applicant amends claims 7, 21, 24, 38, 42, 46, 47, 50, 55, 56-60 and adds new claim 61.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 19-23, 46, 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ara et al (US Patent No. 5,889,597).

Concerning claims 19 and 46, Ara et al discloses an apparatus (Fig. 1) comprising a base unit (1); a scanner apparatus (8) which includes a reading element and can be removably mounted on the base unit 1; scanner mounting portion (2a, 9) provided on the base unit and adapted to removably mount the scanner apparatus on the base unit; engaging portion (10, 14, 16) provided on the scanner apparatus and adapted to engage the scanning mounting portion; wherein a sheet transporting path (17) is defined by a surface of the scanner apparatus on which the reading element is provided, and a surface of the base unit (7) which faces to the scanner apparatus in a case where the scanner apparatus is mounted on the base unit.

Ara does not directly teach that the engaging portion and the scanner mounting portion hold the scanner apparatus in a manner that the scanner apparatus can be rotatable to a direction that the sheet transporting path is open. However, Ara teaches that the engaging portion (hook 10) is pivoted rotatably such that the tip of hook 10 is disposed on each of the sides of the scanner 8 which engages a recess 2a disposed in correspondence with the hook 10 on the side of the outer casing 2 of the printer 1, causing the mounted printer 1 and scanner 8 to be fixed (col. 4, lines 24-34). Thus in order to attach the scanner 8 to printer 1, the scanner 8 has to move forward to be fixed with the printer 1 while the sheet transporting path is open. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider that the scanner 8 can be rotatable to a direction that the sheet transporting path is open

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as claimed since in order to the scanner 8 to printer 1, the engaging portion and the scanner mounting portion have to move the scanner 8 forward to the printer 1.

Concerning claims 20-23, 48-50, Ara further teaches that the scanner is capable of operating as a hand scanner in case where the scanner 8 is detached from the base unit; a lock member locking the scanner 8 in a stated mounted on the base unit 1, and a rotation limiting stopper (9, 13) preventing the scanner 8 from swinging excessively and the base unit 1 is an image forming apparatus (Fig. 1); a deviation preventing stopper (15, 16) preventing the scanner from displacing upwardly of the base unit.

4. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ara et al (US Patent No. 5,889,597) in view of Yamada et al (US Patent No. 5,559,609).

Concerning claim 34, Ara et al discloses an apparatus (Fig.1) comprising a base apparatus (2) which includes a sheet transporting mechanism (5) having a sheet transporting path extending substantially vertically, a scanner apparatus (8) which can be detached from the base apparatus so as to operate as a hand scanner, and includes a reading element, wherein the sheet transporting path is for feeding the original to the scanner for scanning and for feeding the record sheet to the printer for printing (col. 4, lines 1-62; col. 6, line 20 - col. 7, line 14; col. 7, line 66 - col. 8, line 57).

Ara does not teach a second sheet transporting mechanism having a second sheet transporting path wherein the first and second sheet transporting paths are provided along and

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adjacent to each other. Yamada et al teaches a facsimile transceiver (Figs.1, 2) having two different sheet transporting paths such as the document feeder trays 10 and 21 wherein trays 10 and 21 are provided along and adjacent to each other. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the sheet transporting mechanism in Ara to have two sheet transporting path extending substantially vertically and adjacent to each other as taught in Yamada to separate original documents for scanning with recording sheets for printing the scanned documents. That combination would supports an improved apparatus with two different sheet transporting paths for different functions.

Concerning claims 35-36, Ara further teaches that the scanner includes at least one pick up roller (110, Fig.5(A)), a protecting member (115, Fig.5(A)) provided at a location outside of a reading area of the scanner apparatus 8 (Figs. 5(A)-(B); col. 6, lines 29-57).

5. Claims 52-54, 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu (US Patent No. 5,663,811).

Concerning claims 52, Shimizu et al discloses an apparatus (Figs. 2-4) comprising a base unit (100); a scanner apparatus (200) which includes a reading element and can be removably mounted on the base unit 1; a sheet transporting path (100a, A, Fig.4) defined by a surface of the scanner apparatus on which the reading element is provided and a surface of the base apparatus which faces toward the reading element in a case where the scanner apparatus is mounted on the

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base apparatus, and a cover (Fig. 3) of the base apparatus which connects the scanner for guiding a sheet delivered from the sheet transporting path (col. 3, line 39 - col. 4, line 12).

Shimizu does not specifically teach a cover of the base apparatus for guiding a sheet delivered from the sheet transporting path. However, Shimizu teaches in Fig.4 a document insertion unit 100a is detected by the document detection switch 12 to drive a transmission motor M1. This causes the set document to be conveyed through a drive roller 200b and read by the scanner unit 5 within the hand scanner 200. The read document is discharged to the outside through a pinch roller 200c as shown by the arrow A. It is noted that the cover 200 starts with one lower end where the sheet is first inserted and ends with the upper end where the sheet is discharged. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider the cover 200 of the base unit is for guiding a sheet delivered from the sheet transporting for transporting the original image sheet to be scanned since the two ends of the cover are also for guiding the original image sheet.

Concerning claims 53-54, 56-58, Shimizu further teaches that the front cover can be opened, closed and removed; the base apparatus is an image forming apparatus, and a sheet guide of a sheet delivery portion of the image forming apparatus and a sheet guide of a sheet delivery portion of the scanner apparatus are provided adjacent to each other (Fig.4) wherein the sheet feeding portion of the scanner apparatus is provided frontward with respect to a sheet feeding portion of the image forming apparatus.

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Concerning claim 59, Shimizu discloses the apparatus as discussed in claim 52 above. Shimizu further teaches that the image forming apparatus in the base apparatus includes a sheet transporting path extending substantially vertically (path. B, 100c, Fig.4); a scanner apparatus of an automatic sheet feeding type including a sheet transporting path extending vertically (path A, 200, Fig.4) wherein the sheet transporting paths of the scanner and image forming apparatuses are provided adjacent to each other and a sheet guide provided at least a part of the sheet transporting path of the scanner apparatus as a cover for the image forming apparatus.

Concerning claims 60-61, Shimizu further teaches that the scanner 200 is removably mounted on the image forming apparatus, and the scanner is so implemented as to be capable of operating as a hand scanner in a case where the scanner apparatus is detached from the image forming apparatus (Fig. 3); wherein the scanner apparatus includes at least one roller or a plurality of rollers for sheet transportation, a center of rotation of the scanner is located at a downstream side, with regard to a direction of sheet transportation of the rollers (Figs.2-4).

Allowable Subject Matter

6. Claims 7-10, 24-25, 38-45, 51 are allowed.
7. Claims 37, 47 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Dow et al (US Patent No. 5,166,812) discloses a fax machine with retractable drawer including a printer on an upper surface and handy scanner in a retractable drawer.

b. Yamada et al (US Patent No. 5,559,609) teaches a facsimile transceiver with two sheet transporting path which are vertically defined and adjacent to each others.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine Anh-Vinh Nguyen whose telephone number is (703) 305-4860.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communication at s intended for entry)

(703) 308-9051 (for informal or draft communications, such as proposed amendments to be discussed an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.

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Sixth Floor (Receptionist)

A handwritten signature in black ink, reading "Anh-Vinh Nguyen". The signature is written in a cursive, flowing style.

Madeleine Anh-Vinh Nguyen

Primary Examiner

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August 13, 2000